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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,482

09/29/2006

Tomoaki Honda

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EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1781

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,482	<b>Applicant(s)</b> HONDA ET AL.	
	<b>Examiner</b> C. SAYALA	<b>Art Unit</b> 1781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/29/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-18 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/013268.

The patent discloses a foodstuff for cats and dogs that contains astaxanthin. See abstract and claims. Claims 1-18 are drawn to a pet food composition containing astaxanthin. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

2. Claims 1-7, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lignell et al. (US Patent 6054491) or WO 98/37874

1) Lignell et al disclose feeding natural astaxanthin in feed for sow. See col. 4, lines 10-14. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

2) The WO patent teaches feeding mice a feed supplemented with algal meal containing astaxanthin. See page 5, lines 9-11. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

3. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US Patent 6022867).

Ito et al. discloses feeding a feed composition to animals which includes cattle, pigs, horses, dogs, cats and birds, rodent animals, and that contains astaxanthin. See col. 9, lines 30-33, 38-40, 66. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In*

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*re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

4. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Chew et al. (US Pub. 2004/0151761) or Levy et al. (US Pub. 2003/0104090) or Zielinski (US Pub. 2003/0124230).

Chew et al. disclose a food composition that contains astaxanthin as shown in Example 1 to Beagle dogs. See also the claims which include cats or companion animals. The reference discloses feeding the food composition to the animals described at ¶[0032]. Note ¶ [0033] to [0034] that show astaxanthin. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

Levy et al disclose food additives that include the compound, astaxanthin shown at ¶[0025]. At ¶[0029]-[0030], the reference shows that the additive is included in food compositions. At ¶[0026] the reference discloses the list of animals that includes cats, dogs, pigs, birds. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re*

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*Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

Zielinski et al disclose food additives that include the compound astaxanthin shown at ¶[0026]. At ¶[0016]-[0017], the reference shows that the additive is included in food compositions. At ¶[0016] and [0018] the reference discloses the list of animals that includes cats and dogs. Applicant's limitation, "having an effect of", describes properties of the food composition that can be considered to be inherent to the composition. Furthermore, it is well established that the discovery of a new use for an old composition does not render the same old composition new and patentable. See *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/  
Primary Examiner, Art Unit 1781**